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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/608,970	06/30/2000	Kia Silverbrook	NPA015US	1454
24011	7590	01/06/2006	EXAMINER	
SILVERBROOK RESEARCH PTY LTD 393 DARLING STREET BALMAIN, NSW 2041 AUSTRALIA			BACKER, FIRMIN	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 01/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/608,970	SILVERBROOK ET AL.	
	Examiner	Art Unit	
	FIRNM BACKER	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 11-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 22-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1 and 11-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Milovanovic et al (U.S Patent No. 6,484,198) in view of Bobrow et al (U.S. Patent No 6,275,301).
3. As per claims 1 and 20, Milovanovic et al teach a method of collecting a copyright fee relating to a document when a user obtains, via coded data disposed on a surface the document, including a computer system for receiving from a sensing device placed in an operative position relative to the surface indicating data indicative of a request for the document, the sensing device generating the indicating data by sensing at least some of the coded data; and, identity data indicative of an identity of the user, the sensing device containing the identity data, identifying, from the indicating data, the request for the document, providing the document to the user using the request for the document (see column 4 lines 5-5 line 67.). Milovanovic et al fail to teach identifying from the identity data, a user account; determining the copyright fee from at least one copyright ownership; and debiting the user account associated with the user in the amount of the copyright fee. However, Bobrow et al teach an inventive concept of identifying from the identity data, a user account, determining the copyright fee from at least one copyright ownership; and

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debiting the user account associated with the user in the amount of the copyright fee (see column 32 lines 11-33 line 63). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the inventive concept of Milovanovic et al to include Bobrow et al's an inventive concept of identifying from the identity data, a user account, determining the copyright fee from at least one copyright ownership; and debiting the user account associated with the user in the amount of the copyright fee because this would have ensure that the user is billed accordingly, and appropriate copyright royalties flow to the copyright holder.

4. As per claims 11 and 21, Milovanovic et al teach a method of recording at least one copyright ownership relating to at least one portion of the document (see column 4 lines 5-5 line 67).

5. As per claims 12, 23, Milovanovic et al teach a method wherein the coded data is substantially invisible to the naked eye (see column 4 lines 5-5 line 67):

6. As per claims 13, 24, Milovanovic et al teach a method wherein the document includes visible information and wherein at least some of the coded data is coincident to the visible information (see column 4 lines 5-5 line 67).

7. As per claims 14, 25, Milovanovic et al teach a method wherein the coded data is at least partially indicative of an identity, and wherein the computer system is for determining, using the

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indicating data, the identity, determining, using the identity, a page description; and, identifying, using the page description, the request (see column 4 lines 5-5 line 67.).

8. As per claims 15, Milovanovic et al teach a method wherein the identity is at least one of an identity of the form an identity of a region of the form; and, an identity of an interactive element (see column 4 lines 5-5 line 67).

9. As per claims 16, 26, Milovanovic et al teach a method wherein the coded data includes a number of data portions, each data portion having a unique data portion identity indicative of a location of the coded data portion on the form, and wherein the computer system is for determining, from the indicating data, the data portion identity of at least one sensed data portion, determining, using the data portion identity and a map, the location of the at least one sensed data portion; and, determining, using the location, the request (see column 4 lines 5-5 line 67).

10. As per claims 17, 27, Milovanovic et al teach a method wherein the coded data includes a number of data portions, each data portion having a data portion identity, and wherein the computer system is for determining, from the indicating data, the data portion identity of at least one sensed data portion; and, determining, using the data portion identity and the page description using the location, the request (see column 4 lines 5-5 line 67).

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11. As per claims 18, Bobrow al teach a method of crediting at least one owner account associated with the at least one copyright ownership in the amount of the copyright fee (see column 32 lines 11-33 line 6).

12. As per claims 19, 22, Milovanovic et al teach a method of printing the document (see column 4 lines 5-5 line 67).

13. As per claim 28, Milovanovic et al teach a system includes a relay device for receiving the indicating data from the sensing device; and, transferring the indicating data to the computer system (see column 4 lines 5-5 line 67).

14. As per claim 29, Milovanovic et al teach a system wherein the relay device is a printer, the printer including a first communications module for communicating with the sensing device, and, a second communications module for communicating with the computer system (see column 4 lines 5-5 line 67).

Response to Arguments

15. Applicant's arguments filed July 8th, 2005 have been fully considered but they are not persuasive.

- a. Applicant argues that the prior art, Milovanovic taken alone or in combination with Bobrow fail to teach or suggest the use of a sensing device to sense containing the

identity data. Examiner respectfully disagrees with Applicant's characterization of the prior art. Milovanovic among other things teach in one embodiment, one or more electronic tags (e.g. bar codes) are attached by the publisher directly on the published item or a portion of the published item prior to distribution to subscribers. A subscriber receives the subscription through the mail or other off-network basis and sends a request for an electronic equivalent of the published item on the network by swiping or entering *the tag information into a sensing device*. Preferably, the sensing device is an electronic bar code reader coupled directly to the subscriber's computer. A notebook, desktop computer or similar computing means receives the tag information from the sensing device and formats a network compatible request that is transmitted to the publishing authority over the network. *The tag information may include the identity of the subscriber on the network (e.g. the subscriber's e-mail address) and a reference to the particular item being requested by the subscriber (emphasis added)*. The request is received and processed by the publisher who, in turn, formats a response message containing the electronic equivalent of the requested item or a pointer to a network cite (e.g. a URL) containing the item. *(see summary of the invention)*. Furthermore, Bobrow et al teach a system wherein a hypertext link to order a high-resolution hardcopy of the document. Upon issuance of the request, combined with appropriate payment or credit as indicated by arrow, the user's order is transmitted to a print shop or other trusted printing facility, along with a high-resolution representation of the document. A high-resolution printed copy is made from the high-resolution representation. Thereafter, the print shop can mail or deliver high-resolution printed copy to the user, or the user can visit the print shop and

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pick up copy there. The user can comfortably read high-resolution which clearly shows the text and line art of the document. *Meanwhile, the print shop or other trusted printing facility collects and processes the fee and forwards any applicable copyright royalties to the copyright holder or holders. The user's payment can be made, for example, by electronic debit or credit, or over the Internet if a secure pay-by-Internet scheme is available; alternatively, an invoice can be sent to the user* (emphasis added). Therefore the rejection is sustained and made final.

Conclusion

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

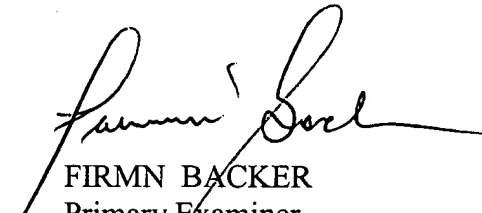
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to FIRMN BACKER whose telephone number is 571-272-6703.

The examiner can normally be reached on Monday - Thursday 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



FIRMN BACKER
Primary Examiner
Art Unit 3621

January 3, 2006